

Serial No.: 09/690,368  
Accompanying Amendment

Docket No. 1005.11  
Customer No. 53953

### **REMARKS**

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 9, 17, 43, 44 and 45 have been amended. Antecedent basis for the amendments is located throughout Applicant's specification, including the discussion of Fig. 3L. Claims 1, 2, 5-10, 13-18 and 21-51 are pending.

#### **35 U.S.C. § 103(a)**

In the Office Action mailed July 3, 2006, claims 1 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,096 ("Kuppusamy") in view of U.S. Patent No. 6,992,687 ("Baird").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:  
storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;  
at a first location within the electronic version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;  
and  
in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause an operation associated with the second location, and wherein the first and second locations are exclusive of one another.

As amended, claim 43 recites:

43. A method performed by a computer system, comprising:  
storing an electronic version of a paper, the electronic version being displayable on a display device as a likeness of the paper;  
at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location; and  
in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device, and wherein the first and second locations are exclusive of one another.

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MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claims 1 and 43, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy, Baird and Applicant's specification, only Applicant's specification teaches the combinations of elements in amended claims 1 and 43. In fact, Kuppusamy and Baird teach away from such combinations.

In citing Kuppusamy, the Office Action states, a "heading is detected within the first location of the quarterly report" (emphasis added). Further, the Office Action states, a "hyperlink entry is created in the TOC document for each selected heading" (emphasis added).

As shown in Kuppusamy's Fig. 3, the target document 202 ("quarterly report," where the heading is detected) and the TOC document 220 (where the hyperlink is created) are independent windows, with each window simultaneously displaying a different document. This fact is explicitly taught in Kuppusamy at col. 6, line 63–col. 7, line 1, which states: (a) "a frameset 218" contains "the target document 202 and the TOC document 220"; and (b) "the term 'frameset' relates to the creation of two or more independent windows with each window simultaneously displaying a different document" (emphasis added).

Consequently, Kuppusamy teaches that: (a) the heading is detected in a first document (i.e., the target document 202, which is displayed in a first window), yet the hyperlink is created in a second document (i.e., the TOC document 220, which is displayed in a second window); and

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(b) the first and second windows are independent.

By comparison, claim 1 includes the following limitations: (a) "at a first location within the electronic version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase"; and (b) "in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause an operation associated with the second location" (emphasis added).

The most recent Advisory Action states, "As taught by Kuppusamy, the reference detected could be the entire display which would include the TOC document and the target document...If the quarterly report and the TOC document are considered to be one single reference within an electronic version, then it would suggest the detection of a reference and the embedding of a hyperlink within the same reference." However, if Kuppusamy is read in such a manner, then Kuppusamy teaches away from the limitation in claim 1 that "the first and second locations are exclusive of one another." Thus, Kuppusamy is contrary to claim 1.

Also, claim 43 includes the following limitations: (a) "at a first location within the electronic version, detecting a reference to a second location within the electronic version, wherein the detected reference includes a page number of the second location"; (b) "in response to the detected reference, embedding a hyperlink within the detected reference, wherein the hyperlink is selectable by a user to cause displaying of the second location on the display device"; and (c) "the first and second locations are exclusive of one another" (emphasis added). Thus, Kuppusamy is contrary to claim 43.

Clearly, therefore, Kuppusamy fails to teach amended claim 1, and in fact teaches away from it. Likewise, Kuppusamy fails to teach amended claim 43, and in fact teaches away from it.

The Office Action acknowledges that Kuppusamy "fails to explicitly state that the embedded hyperlink is found within the detected reference." Nevertheless, the Office Action cites Baird's "selection signal," "page object," and "visual indicator." By "page object," the Office Action appears to be citing Baird's "bookmark object."

Claim 1 recites "*at a first location within the electronic version, detecting a reference to a second location*" and "*wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase*," yet Baird's selection signal is a user-generated selection signal. Moreover, claim 1

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recites “*embedding a hyperlink within the detected reference*,” yet Baird clearly fails to teach embedding a hyperlink within Baird’s selection signal. Consequently, Baird’s selection signal cannot satisfy the “*detected reference*” in Applicant’s claim 1.

Thus, with respect to the “*detected reference*” in Applicant’s claim 1, the Office Action appears to be citing Baird’s visual indicators 301, 305, 401 and 403, which comprise information (e.g., respective page numbers) that identify parts (of a document) that are marked by the visual indicators 301, 305, 401 and 403.

With respect to the “*embedding a hyperlink within the detected reference*” in Applicant’s claim 1, the Office Action appears to be citing Baird’s creation of a bookmark object that is linked (e.g., hyperlinked) to a particular part (e.g., page) of a document.

Baird explicitly teaches that its bookmark object is generated “substantially contemporaneously” with rendering its visual indicator. For example, at col. 8, lines 47-48, Baird states, “FIG. 7 is a flow chart illustrating the operation of bookmarks in accordance with the present invention.” At col. 8, lines 56-60, Baird states, “In response to the selection signal, at step 702, a visual indicator is rendered on the display that is currently displaying the document being marked. At step 703 and substantially contemporaneously with step 702, a bookmark object is also generated” (emphasis added).

Consequently, Baird’s bookmark object (step 703) is *not* generated *in response to* its visual indicator (step 702). Instead, Baird explicitly teaches that both steps 702 and 703 occur “substantially contemporaneously” in response to a user-generated selection signal. For example, at col. 5, lines 8-15, Baird states, “As known in the art, by ‘clicking’ the mouse while the cursor 211 is pointing to the point 213, a selection signal is generated indicating that the user has selected the point 213. Alternatively, where a touch screen is used, a user need not control a position of a cursor, but may instead simply ‘tap’ the screen at the selected point 213 in order to generate the selection signal. Regardless of the method used, the selection signal generated in this manner can be used to create a bookmark as described in greater detail below.” Further, at col. 9, lines 6-7, Baird states, “As described above, the processing of steps 702 and 703 occurs automatically in response to the selection signal.” At col. 9, lines 13-17, Baird states, “In this case, before steps 702 and 703 are carried out, the user is first presented with a choice of which action they would like to perform. Steps 702 and 703 would then be executed after the user has elected to create a bookmark based on his selection signal.”

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Therefore, Baird explicitly teaches that both steps 702 (visual indicator) and 703 (bookmark object) occur “substantially contemporaneously” in response to a user-generated selection signal. Consequently, Baird’s bookmark object (step 703) is *not* generated *in response to its visual indicator* (step 702). Thus, even if the Office Action reads “visual indicator” as being “*detected reference*,” and reads “generating a bookmark object” as being “*embedding a hyperlink within the detected reference*,” Baird would explicitly teach away from Applicant’s claim 1, which recites (in part), “*in response to the detected reference, embedding a hyperlink within the detected reference*.”

Clearly, therefore, Baird fails to teach amended claim 1, and in fact teaches away from it. Likewise, Baird fails to teach amended claim 43, and in fact teaches away from it.

Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant’s teachings in its own specification. In relation to amended claims 1 and 43, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy, Baird and Applicant’s specification, only Applicant’s specification teaches the combinations of elements in amended claims 1 and 43. In fact, Kuppusamy and Baird teach away from such combinations.

Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of amended claims 1 and 43 is not supported. Likewise, a rejection of amended claims 9, 17, 44 and 45 is not supported.

### Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 9, 17, 43, 44 and 45.

Dependent claims 2, 5-8, 25-30, 46 and 47 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 10, 13-16, 31-36, 48 and 49 depend from and further limit claim 9 and therefore are allowable.

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Dependent claims 18, 21-24, 37-42, 50 and 51 depend from and further limit claim 17 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 5-10, 13-18 and 21-51 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.


Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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